

REMARKS/ARGUMENTS

In the above-mentioned Office Action, claim 366 was rejected under Section 112, first paragraph, claims 359, 364, 368-370, 374, 375, 380 and 383-385 were rejected as anticipated by U.S. Patent No. 5,198,275 (Klein), claims 360-362 were rejected as being unpatentable over Klein in view of U.S. Patent No. 5,407,718 (Popat et al.), claims 363, 371, 372, 377-379, 382, and 386-388 were rejected as being unpatentable over Klein, claims 143, 182-194, 196-200, 213-283 and 292-358 were allowed, and claims 365, 367, 373, 376 and 381 were objected to but would be allowable if rewritten in independent format. Responsive thereto claims 380-388 have been cancelled without prejudice or disclaimer and new claims 389-399 have been added.

The allowance of claims 143, 182-194, 196-200, 213-283 and 292-358 is acknowledged with appreciation. These claims remain in the application.

Claim 366 complies with the written description requirement, Applicants respectfully contend. The adhesive can be part of a laminate construction between the facestock and the film, as is disclosed in the specification as an alternative.

The examiner rejected claim 359 over Klein. This rejection is respectfully traversed. The examiner stated that the cut lines to form the perimeter edges of the printable business cards are shown by lines 200. Cut lines 200 form the business card 80 as shown in Fig. 4 of Klein. Referring thereto it is seen that the back side of business card 80 is formed by the back side of the liner sheet 90. It is not formed by the back side surface of the facestock sheet as is claimed in claim 359.

New claim 390 is old dependent claim 383 rewritten in independent format, and it similarly claims that "portions of the back side of the facestock sheet form back sides of the printable business cards."

Claim 360 and claims 361 and 362 depending therefrom were rejected as being unpatentable over Klein in view of Popat. The examiner stated that it would have been obvious to make the liner 90 of Klein a solid liner without the cut lines (300) when individual cards are not desired to be separated completely from the construction. It is respectfully contended that the examiner's proposed modification of Klein in view of Popat is an improper Section 103 rejection.

The examiner's attention is directed to MPEP 2143.01 where it is stated that "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

(It is further stated in that section of the MPEP that "[i]f the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the prior art are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).")

That is exactly what the examiner has done in her rejection, Applicants respectfully contend. Klein is directed to improvements in the severability of comparatively thick paper sheets such as cardstock or the like, and more particularly to the severability of cardstock by combining closely spaced perforations and score cuts. A primary object of Klein is to provide a method for micro-perforating and score cutting a cardstock sheet which permits the manual separation of individual cards therefrom having comparatively smooth even edges.

There is no suggestion for removing the lines 300 such as shown in Fig. 6 of Klein. Because then to separate the cards 80 from the cardstock sheet would require ripping with ragged edges the back sheet at the front sheet cut lines 200.

New independent claim 399 is similarly patentable.

Concluding Remarks

Accordingly, all claims are allowable and issuance of the Notice of Allowance is in order.

If for any reason the Examiner finds the application other than in condition for allowance, she is respectfully requested to telephone Applicants' undersigned counsel at (213) 689-5142 to discuss the steps necessary for placing the application in condition for allowance.

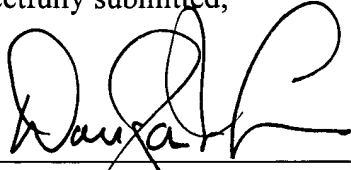
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional

fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,

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By



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